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| 09/923,213 | 08/06/2001 | Lynn Henry Wheeler | 10399-34384 | 8986 |

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EXAMINER

SCHUBERT, KEVIN R

ART UNIT PAPER NUMBER

2137

DATE MAILED: 09/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/923,213

Applicant(s)

WHEELER ET AL.

Examiner

Kevin Schubert

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 08062001; 01272003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: IDS: 08142003.

DETAILED ACTION

Claims 1-5 have been considered.

Election/Restrictions

- 5 Claims 6-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected group, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 8/10/05.

Information Disclosure Statement

- 10 It should be noted that the applicant has submitted an exorbitant amount of prior art on numerous PTO-1449's which, on initial consideration, do not all appear to have relevancy or pertinence to the instant invention as claimed. The applicant is requested in response to this office action to point out which of these numerous prior art are pertinent or relevant to the patentability of the invention as claimed in this instant application. It should be noted that it would be advantageous to provide a concise
- 15 explanation of why each of the prior art is being submitted and how it is understood to be relevant. "Concise explanations are helpful to the Office, particularly where documents are lengthy and complex and applicant is aware of a section that is highly relevant to patentability or where a large number of documents are submitted and applicant is aware that one or more are highly relevant to patentability." (See MPEP 609 under subheading "A. CONTENT").
- 20

Double Patenting

- 25 The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

- 30 A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5 Claims 1-5 of the instant application are rejected by U.S. Patent No. 6,915,430, U.S. Patent No. 6,892,302, copending U.S. Patent Application No. 10/248,626, and copending U.S. Patent Application No. 10/248,629. A discussion of how independent claim 1 is met by each of the four cases is cited below. The examiner notes that the dependent claims are met by the four cases as well but haven't been specifically discussed for the sake of brevity.

10 Claims 17 of U.S. Patent No. 6,915,430 contains every element of claim 1 of the instant application and as such anticipates claim 1 of the instant application. Claim 18 of U.S. Patent No. 6,892,302 contains every element of claim 1 of the instant application and as such anticipates claim 1 of the instant application. Claim 28 of copending U.S. Patent Application No. 10/248,626 contains every element of claim 1 of the instant application and as such anticipates claim 1 of the instant application.

15 Claim 35 of copending U.S. Patent Application No. 10/248,629 contains every element of claim 1 of the instant application and as such anticipates claim 1 of the instant application.

 "A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or anticipated by, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over

20 claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus)." Eli Lilly and Company v Barr Laboratories, Inc., United States Court of Appeals for the Federal Circuit, On Petition for Rehearing en Banc (Decided: May 30, 2001).

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Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Fischer, U.S. Patent No. 5,422,953.

As per claim 1, the applicant describes a method of manufacturing devices comprising the following limitations which are met by Fischer:

a) creating a public-private key pair within the secured environment (Col 4, lines 29-34; Fig 2);

b) storing the private key within the device against the possibility of divulgement thereof by the device (Col 4, lines 29-34; Col 6, lines 10-65);

c) securely linking the public key with other information within the secure environment (Col 6, lines 10-65).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer in view of Spies, U.S. Patent No. 6,230,269.

As per claim 2, the applicant describes the method of claim 1, which is met by Fischer, with the following limitation which is met by Spies:

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Wherein each private-public key pair is created within each device based on a random number produced by a random number generator disposed within each device (Spies: claim 16);

Fischer discloses all the limitations of claim 1. Fischer even discloses the use of a random number generator. However, Fischer does not specifically disclose that the public-private key pair is
5 produced using the random number generator.

Spies discloses a public-private key pair being produced from a random number generator. It would have been obvious to one of ordinary skill in the art at the time the invention was filed to combine the ideas of Spies with those of Fischer because using a random number generator to produce a key pair ensures freshness of the key pair.

10

As per claim 3, the applicant describes the method of claim 2, which is met by Fischer in view of Spies, with the following limitation which is met by Fischer:

Wherein each digital signature generated by each device is a random number (Fischer: Col 4, lines 2-7).

15

As per claim 4, the applicant describes the method of claim 2, which is met by Fischer in view of Spies, with the following limitation which is met by Fischer:

Wherein the other information comprises respective security features and a manufacturing history of each device (Fischer: Col 6, lines 10-65).

20

As per claim 5, the applicant describes the method of claim 2, which is met by Fischer in view of Spies, with the following limitation which is met by Fischer:

Further comprising identifying a particular manufactured device by authenticating a message using one of said linked public keys, a digital signature for the message having been generated by the
25 particular manufactured device (Fischer: Col 7, lines 20-34).

Conclusion

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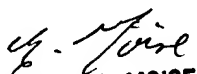
This action is made non-final.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Schubert whose telephone number is (571) 272-4239. The examiner can normally be reached on M-F 7:30-6:00.

- 5 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

- 10 Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

15 KS


EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER